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REMARKS

Allowable Subject Matter

The Examiner objected to Claims 11, 12, 19, and 20 as being dependent upon a rejected base claim, but which would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants appreciate the Examiner's diligence in determining that the above claims are allowable. However, it is believed that other broader claims are allowable and the rationale for this belief is respectfully presented below.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show operation of methods as described in the specification. The Examiner objected to the lack of flowcharts demonstrating the operation of the method claimed by the applicant.

With reference to the objection to the drawings under 37 CFR 1.83(a), it is respectfully submitted that the claims are directed to a method and MPEP 601.01(f) states in relevant part:

“...35 U.S.C. 113 (first sentence) in turn provides that an “an applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.

...

It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). ...” [underlining for clarity]

The Examiner also indicated that “while referred to in claim and the specification the use of a receiver, a equalizer, and a spectrum analyzer is not supported in the drawings illustrating the use of these functions / functional blocks” and cited MPEP § 608.02(d):

“Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing.

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It is respectfully submitted that the above is also subject to MPEP 601.01(f), *supra*, that a drawing is not necessary for understanding of a method invention.

Specification

The Abstract is objected to for containing more than 150 words and for using improper language and format for an abstract of the disclosure.

The Abstract has been amended to be within 150 words and to delete improper language.

Claim Rejections - 35 USC § 101

Claim 1 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

The Examiner states:

"The steps of claim 1, storing, analyzing and displaying could be accomplished using pencil and paper along existing test equipment, therefore it is deemed to non-statutory subject matter."

Applicants respectfully request citation of the section of the MPEP or case upon which this rejection is based.

The rejection appears to be a variant of the now discredited "mental steps" doctrine which was overruled in *In re Prater*, 415 F.2d 1378, 159 USPQ 583 (C.C.P.A. 1968) and *Ex parte Nassim*, Appeal No. 91-2486 (B.P.A.I. 1991)(unpublished).

Further, it is respectfully submitted that the Applicant's invention is on all fours with *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 22 USPQ 2d 1033 (Fed. Cir. 1992) in which the claim related to a method for analyzing electrocardiograph signals. The Court stated:

"[the] claimed steps of 'converting', 'applying', 'determining', and 'comparing' are physical process steps that transform one physical, electrical signal into another... [T]he method is properly viewed as a method of analyzing electrocardiograph signals in order to determine a specified heart activity."

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Similarly, the Applicant's invention with the claimed steps of "storing", "analyzing", and "displaying" are the physical process steps that transform the device hardware and software data in order to determine a "specified" device "activity".

Therefore, it is respectfully submitted that claims 1-20 are statutory subject matter under 35 USC §101.

Claim Rejections - 35 USC §102

Claims 1 - 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Pottinger et al. (U.S. Patent No. 4,918,708, hereinafter "Pottinger").

With regard to claim 1, Applicants respectfully traverse the rejections since the Applicants' claimed combination includes the limitation not disclosed in Pottinger of:

"analyzing said components of said received points of respective of said groups in relation with their respective of said ideal components of said ideal values to quantify said impairments of said signal and provide calculated values of the same;" [underlining for clarity]

The Examiner states:

"(b) analyzes said components of said received points of respective of said groups (see Figure 7 System Model block and Compute Mean Square block and calculation techniques as described in Column 6, lines 25 - 67; Column 7, 1 - 68; and Column 8, 1-56);"

As shown in Pottinger FIG. 7 and explained in col. 8, lines 57-61 (summarizing col. 6, lines 25-67; col. 7, 1-68; and col. 8, 1-56), the signals are mathematically processed to compute signal measurements (such as a mean square) but do not quantify the impairments of a signal:

"The examples given above relate to the measurement of linear effects. It is also possible to use the device to measure non-linear effects. Non-linear effects can arise from the M-level signals at the modulator, from the predistorter and from the travelling wave tube." [underlining for clarity]

Since claim 1 contains statutory subject matter, claim 1 is allowable under 35 U.S.C. §102(b) because:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" [emphasis added] Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co. (730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir.

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1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed Cir. 1983)))

With regard to claim 2, this dependent claim depends from independent claim 1 and is believed to be allowable since it contains all the limitations set forth in the independent claim from which it depends and claims unobvious combinations thereof.

In addition, Applicants respectfully traverse the rejection since the Applicants' claimed combination includes the limitation not disclosed in Pottinger of:

"d) storing said calculated values of said impairments, thereby allowing an unmanned monitoring of said communication signal." [underlining for clarity]

The Examiner states:

"Pottinger shows an HP-1B interface in Figure 3B (82) which is used to remotely control and access system data for the remote monitoring of signals."

It is respectfully submitted that Pottinger FIG. 3B, interface 82, is not a mechanism for storing calculated values of impairments and, therefore, the claimed method limitation would not read on a method involving interface 82.

With regard to claim 3-7, these dependent claims directly or indirectly depend from independent claim 1 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

Based on all the above, it is respectfully submitted that claims 1-7 are not anticipated under 35 U.S.C. 102(b) and further, since implicit in any 35 U.S.C. 102 rejection is an obviousness rejection under 35 U.S.C. 103, are not obvious based on Pottinger.

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Claims 14-18 are rejected under 35 U.S.C. §102(b) as being anticipated by Kletsky et al. (U.S. Patent No. 5,751,766, hereinafter "Kletsky").

With regard to claim 14, Applicants respectfully traverse the rejections since the Applicants' claimed combination includes the limitation not disclosed in Kletsky of:

"(b) analyzing said plurality of operating parameters to quantify said signal parameters of said signal and provide calculated values of the same;" [underlining for clarity]

The Examiner states:

"(b) Kletsky for detecting and quantifying parameters of a received communication signal...(see Column 7, lines 55 - 62)..."

However, Kletsky does not disclose quantifying parameters in Kletsky col. 7, lines 55-62, which states:

"[W]orkstation 406 derives and displays on display device 408 combinations of the following:...[parameters]" [underlining, deletions, and insertions for clarity]

It is respectfully submitted that claim 14 is allowable under 35 U.S.C. 102(b) because:

"If the reference fails to teach or suggest even one limitation of the claimed invention, then the claim is not anticipated." *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

With regard to claim 15-18, these dependent claims respectively depend from independent claim 14 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

Based on all the above, it is respectfully submitted that claims 14-18 are not anticipated under 35 U.S.C. 102(b), and further, since implicit in any 35 U.S.C. 102 rejection is an obviousness rejection under 35 U.S.C. 103, are not obvious based on Kletsy.

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Claims 15 - 18 are believed to be rejected under 35 U.S.C. §102(b) as being anticipated by Tsui et al. (U.S. Patent No. 6,278,730, hereinafter "Tsui") since Tsui was the only reference applied and the heading indicated the section related to rejections under 35 U.S.C. §102.

With regard to claim 15-18, these dependent claims directly or indirectly depend from independent claim 14 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof. Applicants respectfully traverse the rejections since the Applicants' claimed combination includes the limitation of claim 14 not disclosed in Tsui of:

"b) analyzing said plurality of operating parameters to quantify said signal parameters of said signal and provide calculated values of the same;"
[underlining for clarity]

Based on the above, it is respectfully submitted that claims 15-18 are not anticipated under 35 U.S.C. 102(b) since they depend from claim 14 and further, since implicit in any 35 U.S.C. 102 rejection is an obviousness rejection under 35 U.S.C. 103, are not obvious based on Tsui.

Claim Rejections - 35 USC §103

Claims 8-10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsui (U.S. Patent No. 6,278,730, hereinafter "Tsui") in view of Pottinger (U.S. Patent No. 4,918,708, hereinafter "Pottinger").

With regard to claim 8-10 and 13, these dependent claims directly or indirectly depend from independent claim 1 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

In addition, MPEP §2143.01 states:

"The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)"

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The Examiner states as the motivation:

"It would have been obvious to one skilled in the art to take Pottinger's single channel design and combine it with Tsui's multi-channel design to devise a test set that could measure the system response of a broadband system."

It is respectfully submitted that the Examiner is relying upon the skill in the art to provide the motivation for the combination against the statement of MPEP §2143.01 and the statement of motivation is insufficient to establish a prima facie case of obviousness.

More particularly, as explained in *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), the application was directed to a method of automatically displaying functions of a video display device and demonstrating how to select and adjust the function in order to facilitate response by the user. The examiner rejection was based on obviousness based on two references. One reference was for a television menu for adjusting the picture and audio functions without a demonstration of how to adjust the functions. The other reference was for a videogame having a demonstration mode without showing adjusting the picture or audio functions. The Examiner's rationale for the combination was that it:

"would have been obvious to one of ordinary skill in the art since the demonstration mode is just a programmable feature which can be used in many different device(s) for providing automatic introduction by adding the proper programming software," and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial."

On appeal to the Board, the Board upheld the rejection by stating:

"The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

However, the CAFC vacated and remanded stating in particular that the Board's rejection of the need "for any specific hint or suggestion in a particular reference" to support the combination of the references was an "[o]mission of a relevant factor required by precedent [which] is both legal error and arbitrary agency action." [insertion and underlining for clarity]

Based on MPEP §2143.01, it is respectfully submitted that claims 8 - 10, 13 are allowable under 35 U.S.C. 103(a) as being unobvious over Tsui in view of Pottinger.

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Conclusion

In view of the above, it is submitted that the claims are in condition for allowance and reconsideration of the rejections is respectfully requested. Allowance of claims 1-20 at an early date is solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including any extension of time fees, to Deposit Account No. 50-0374 and please credit any excess fees to such deposit account.

Respectfully submitted,



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Date: February 3, 2005